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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,337	08/08/2001	Shell S. Simpson	10007652-1	1943

7590 11/03/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

HOLLAR, ANDREA B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

es

Office Action Summary	Application No. 09/923,337	Applicant(s) SIMPSON ET AL.	
	Examiner Andrea B. Hollar	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 2,3,6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because paragraph 73, line 9 refers to number 74 as "external user profile," however figure 1 shows number 74 referring to a structure labeled as "Int. User Profile." All references to number 74 should match. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "367" and "368" have both been used to designate "Reference to Def. Int. Graphic Store" in figures 3 and 4. Corrected drawing sheets in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "367" and "368" have both been used to designate "Reference to Def. Int. Composition Store" in figures 3 and 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities.

Paragraph 114, line 12 contains an extra period. The extra period should be deleted.

Paragraph 147, lines 7 and 15-16 and paragraph 148, lines 6 and 8 refer to number 20 as "user identification" rather than "user information" as it is called in figure 5 and elsewhere in the specification. The differing references should be modified to match all other references to number 20.

Paragraph 149, line 1 indicates that the reader should refer to figure 4. The subsequent reference numbers are shown on figure 5 rather than figure 4. It is assumed that "figure 4" is a typographical error and should be corrected to say "figure 5."

Appropriate correction is required.

Claim Objections

Claims 2, 6, and 12 are objected to because of the following informalities: "web service" lacks antecedence. Appropriate correction is required.

Claim 3 is objected to because of the following informalities: "define" is a typographical error. It should be changed to "defined". Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a program. A program is non-statutory unless it is contained on some computer readable medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 recites the limitation "the requestor" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the capabilities of each" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the translated content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the translated content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the user" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the translating the content step" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the translating the content step" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "labeled content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the layout" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Ferrel.

With respect to claim 1, Wright discloses a web service method for providing imaging conversion services on content, comprising the steps of:

receiving content (col. 10, lines 31-32; col. 12, lines 12-19);

selecting an imaging conversion program based on a criteria (fig. 5, items 41A-D; col. 10, lines 56-57);

converting the content using the selected imaging conversion program to obtain converted content (col. 11, lines 25-26; fig. 5, items 41, 41A-D, 50); and

transmitting the converted content to a desired location (col. 11, lines 29-30; fig. 5, item 42).

Wright does not disclose expressly a step for obtaining a style sheet.

Ferrel discloses a step for obtaining a style sheet (fig. 1, item 110; col. 8, line 1).

Wright and Ferrel are analogous art because they are both from the same field of endeavor of electronic document formatting.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add Ferrel's step of obtaining a style sheet to Wright's method of document formatting.

The motivation for doing so would have been to provide Wright's method with the capability to utilize the format standardization found in style sheets.

Therefore, it would have been obvious to combine Ferrel with Wright for the benefit of format standardization to obtain the invention as specified in claim 1.

With respect to claim 2, Wright further discloses that the web service is at a web site identified by a URL reference (col. 11, lines 60-61).

With respect to claim 3, Wright does not disclose expressly that the content is obtained from a source web site that is different from the web service web site; and wherein the obtaining a style sheet step comprises receiving a style sheet from the source web site.

Ferrel discloses that it is known that both content and a style sheet can be obtained from a source web site that is different from the web service web site (fig. 1, items 110, 112 and 122).

At the time of the invention it would have been obvious to a person of ordinary skill in the art that both the content and the style sheet for Wright's document formatting method could be obtained from a website other than the web service website over the Internet or another network.

The motivation for doing so would have been to allow Wright's method of document formatting to be used on documents other than those that reside only on the

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terminal computer and to use style sheets other than those that reside only on the terminal computer.

Therefore, it would have been obvious to combine Ferrel with Wright for the benefit of a wider range of document and style sheet selection to obtain the invention as specified in claim 3.

With respect to claim 4, Wright does not disclose expressly that the content is obtained from a source web site that is different from the web service web site; and wherein the obtaining a style sheet step comprises selecting a default style sheet.

Ferrel discloses that it is known that content can be obtained from a source web site that is different from the web service web site (fig. 1, items 112 and 122) and that a default style sheet can be used when formatting documents (Fig. 5, items 340 and 344).

At the time of the invention it would have been obvious to a person of ordinary skill in the art that in reference to Wright's method of document formatting, the content could be obtained from a website other than the web service website over the Internet or another network and that Wright's style sheet could be a default style sheet, as Ferrel teaches.

The motivation for doing so would have been to allow Wright's method of document formatting to be used on documents other than those that reside only on the terminal computer and to use a default style sheet when no other style sheet is specified.

Therefore, it would have been obvious to combine Ferrel with Wright for the benefit of a wider range of document and style sheet selection to obtain the invention as specified in claim 4.

With respect to claim 5, Wright discloses that the criteria for the selecting a conversion program step comprises selecting a conversion program based on a parameter of a printer to be used to print the content (col. 11, lines 12-13). Resolution is a "parameter of a printer" and it would be obvious to one of ordinary skill in the art that a terminal that is capable of utilizing Wright's method could have a printer connected to it for use in printing the converted content.

With respect to claim 6, Wright discloses that the criteria for the selecting a conversion program step selects a conversion program dynamically based on a negotiation taking place between the web service and the requestor and based on the capabilities of each (col. 4, lines 10-16). When the user authenticates (negotiates) with the method, a user profile is selected that determines the set of image standardization criteria, and thus the conversion program that will be used to convert the content.

With respect to claim 7, Wright further discloses that the transmitting step comprises the step of transmitting the translated content to a consuming web site or service (col. 10, lines 48-50).

With respect to claim 8, Wright further discloses that the transmitting step comprises transmitting the translated content to storage in a personal imaging repository (col. 8, lines 40-45; col. 9, lines 48-50).

With respect to claim 9, Wright further discloses that the transmitting step comprises transmitting a reference to the converted content, with the reference referring to the converted content (col. 4, lines 56-60; fig. 5, item 46).

With respect to claim 10, Wright does not disclose that the selecting an imaging conversion step comprises associating a reference for the selected imaging conversion program to the content or to a reference for the content and making that content or the content reference accessible to the user, to thereby permit the converting step to be performed on a demand basis.

It would be obvious to one of ordinary skill in the art to use this type of reference for a document or content file. It is well known in the art that one can add an extension to a filename that indicates that a particular conversion program is to operate on the file to produce the converted content. For example, "filename.txt" indicates that a text editor should be used to produce the converted content. This type of extension is accessible to the user, thereby allowing the conversion to be done on an on-demand basis whenever the file is accessed by the user.

With respect to claim 11, Wright does not disclose that the receiving content step comprises receiving a reference to the content and associating the content reference to a reference for the web service method and making this content reference accessible to a user, so that the conversion services may be performed on a demand basis.

It would be obvious to one of ordinary skill in the art to allow Wright's method to receive content by reference. It is well known in the art that a reference such as a web address, or URL, can contain an extension that denotes what method is to be used to

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convert the content. For example, "www.website.com/filename.txt" indicates that a text editor should be used to produce the converted content located at this reference. This reference is accessible to the user, thereby allowing the conversion to be done on an on-demand basis whenever the reference is accessed by the user.

With respect to claim 12, Wright further discloses that the converted content is stored on the web service (col. 11, lines 29-30).

With respect to claim 17, Wright further discloses that the said obtaining a style sheet step comprises allowing a user to configure a style sheet for use with the method (col. 11, lines 8-9).

With respect to claim 18, Wright further discloses that the transmitting step comprises transmitting the content to another service (col. 10, lines 48-50).

With respect to claim 19, Wright discloses a web service system for providing imaging conversion services on content, comprising:

- a component for receiving content (fig. 5, item 40);

- a component for selecting an imaging conversion program based on a criteria (fig. 5, items 41, 41A-D);

- a component for converting the content using the selected imaging conversion program to obtain converted content (fig. 5, items 41A-D, 50); and

- a component for transmitting the converted content to a desired location (fig. 5, item 42).

Wright does not disclose expressly a component for obtaining a style sheet.

Ferrel discloses a component for obtaining a style sheet (fig. 1, item 110; col. 8, line 1).

Wright and Ferrel are analogous art because they are both from the same field of endeavor of electronic document formatting.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add Ferrel's component of obtaining a style sheet to Wright's system of document formatting.

The motivation for doing so would have been to provide Wright's system with the capability to utilize the format standardization found in style sheets.

Therefore, it would have been obvious to combine Ferrel with Wright for the benefit of format standardization to obtain the invention as specified in claim 19.

With respect to claim 20, Wright discloses a program product for implementing a web service method for providing imaging conversion services on content, comprising computer readable code (col. 10, line 17) for performing the following method steps:

receiving content: col. 10, lines 31-32; col. 12, lines 12-19);

selecting an imaging conversion program based on a criteria (fig. 5, items 41A-D; col. 10, lines 56-57);

converting the content using the selected imaging conversion program to obtain converted content (col. 11, lines 25-26; fig. 5, items 41, 41A-D, 50); and

transmitting the converted content to a desired location (col. 11, lines 29-30; fig. 5, item 42).

Wright does not disclose expressly a step for obtaining a style sheet.

Ferrel discloses a step for obtaining a style sheet (fig. 1, item 110; col. 8, line 1).

Wright and Ferrel are analogous art because they are both from the same field of endeavor of electronic document formatting.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add Ferrel's step of obtaining a style sheet to Wright's method of document formatting.

The motivation for doing so would have been to provide Wright's method with the capability to utilize the format standardization found in style sheets.

Therefore, it would have been obvious to combine Ferrel with Wright for the benefit of format standardization to obtain the invention as specified in claim 1.

Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Aua.

With respect to claim 13, Wright does not disclose expressly that the translating step comprises filtering the content to delete selected items therein.

Aua discloses that it is known that when translating content, it is possible to filter the content and delete selected items (par. 0038, lines 2-4).

With respect to claim 16, Wright does not disclose expressly that the converting the content step comprises changing the layout of the content on a page.

Aua discloses that it is known that when converting content, it is possible to change the layout of the content on a page (par. 0040, lines 3-4; par. 0047, lines 1-2).

Wright and Aua are analogous art because they are both from the same field of endeavor of electronic document formatting.

At the time of the invention it would have been obvious to a person of ordinary skill in the art that Wright's method could be modified to include filtering and deleting unwanted items and changing the layout of content on a page, as taught by Aua.

The motivation for doing so would have been to allow Wright's method to produce a finished product with only the desired components contained therein and with only the desired layout.

Therefore, it would have been obvious to combine Aua with Wright for the benefit of producing the desired document to obtain the invention as specified in claims 13 and 16.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Berger.

With respect to claim 14, Wright does not disclose that the translating the content step comprises labeling different items in the content.

Berger discloses that it is known that when translating content, it is possible to label different items in the content (par. 0034, lines 1-2; par. 0040, lines 10-11, noting subdoc labels in table).

With respect to claim 15, Wright does not disclose that labeled content can be reordered.

Berger discloses that labeled content can be reordered within a document (par. 0098, line 2).

Wright and Berger are analogous art because they are from the same field of endeavor of electronic document formatting.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Wright's method to allow content to be labeled and reordered, as taught by Berger.


The motivation for doing so would have been to allow segments of documents produced with Wright's method to be labeled and subsequently manipulated in ways such as reordering to produce the desired document.

Therefore, it would have been obvious to combine Berger with Wright for the benefit of producing the desired document to obtain the invention as specified in claims 14 and 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea B. Hollar whose telephone number is n/a. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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